

RECEIVED
CENTRAL FAX CENTER

04:46:54 p.m. 10-07-2005

OCT 07 2005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re United States Patent Application of:)	Docket No.:	2771-686 CIP (7493)
Applicants:)	Conf. No.:	4186
Application No.:)	Art Unit:	2813
Date Filed:)	Examiner:	NGUYEN, Tuan H.
Title:)	Customer No.:	25559
)		
)		
)		
)		
)		
)		

FACSIMILE TRANSMISSION CERTIFICATE

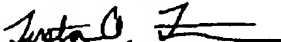
ATTN: Examiner Tuan NGUYEN

Fax No. (571) 273-8300

I hereby certify that this document is being filed in the United States Patent and Trademark Office, via facsimile transmission to Mail Stop Amendment, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450, on October 7, 2005 to United States Patent and Trademark Office facsimile transmission number (571) 273-8300.

3

Number of Pages



Tristan A. Fuierer

October 7, 2005

Date

RESPONSE TO RESTRICTION REQUIREMENT IMPOSED IN SEPTEMBER 29, 2005
OFFICE ACTION IN U.S. PATENT APPLICATION NO. 10/782,355

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

In the September 29, 2005 Office Action, the Examiner imposed a restriction requirement against claims 1-40, and required that an election be made between:

Group I: claims 1-18, drawn to an etching composition, classified in class 156, subclass 345.11+; and

Group II: claims 19-40, drawn to a method for etching, classified in class 438, subclass 753+.

Applicants hereby elect, with traverse, Group I claims 1-18 drawn to an etching composition.

The traversal is based on the fact that the rationale for restriction is in error. The Office Action states that "the device¹ of the Group I invention could be made by processes materially different than that of the Group II invention, for example, the silicon-containing substances could be etched by dry etching with different etchant [sic] rather than wet etching method" (see page 2 of the Office Action).

In fact, the composition recited in claim 1 is the same as that recited in method claim 19, insofar as the specifically recited ingredients of the composition is concerned, and thus is not independent and distinct from claim 1, as is necessary under 35 U.S.C. §121 as a basis for proper restriction.

It therefore is requested that the restriction requirement be reconsidered, and that all claims 1-40 be retained in consolidated form for further examination and prosecution on the merits.

If the restriction requirement nonetheless is made final, applicants alternatively request rejoinder of method claims 19-40 under the provisions of MPEP §821.04 upon confirmation of allowable subject matter of the Group I claims 1-18.

Such rejoinder would be fully proper under these circumstances for the following reasons.

¹ it is noted that the Group I invention is not a device but rather a composition.

When an application as originally filed discloses a product and the process for making and/or using such product, and only the claims directed to the product are presented for examination, when a product claim is found allowable, applicant may present claims directed to the process of making and/or using the patentable product for examination through the rejoinder procedure in accordance with MPEP §821.04, provided that the process claims depend from or include all the limitations of the allowed product claims.

In the present application the elected claims 1-18 are directed to sacrificial silicon-containing layer etching compositions and the non-elected claims 19-40 are directed to a method of using said compositions for removing silicon-containing substances from a substrate. Consistent with the provisions of the MPEP §821.04, when the product claims 1-18 are subsequently found allowable, the withdrawn method of use claims 19-40 may be rejoined for examination.

Respectfully submitted,



Tristan A. Fuierer
Reg. No. 52,926
Attorney for Applicants

INTELLECTUAL PROPERTY/
TECHNOLOGY LAW
Phone: (919) 419-9350
Fax: (919) 419-9354
Attorney File No.: 2771-686 CIP (7493)